



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

Jeffrey Fasnacht

Serial No.: 10/614,616

Filed: July 7, 2003

Title: **POLYCARBONATE SPINNERBAIT
LURE FRAME**

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) Group Art Unit: 3643
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) Examiner: David J. Parsley
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejections of the Examiner in the Final Office Action mailed on August 29, 2005. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. This review is requested in view of the remarks that follow.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as EXPRESS MAIL in an envelope addressed to: MAIL STOP AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on December 16, 2005.

Name: Terasa Zurawski

Terasa Zurawski Dec. 16, 2005
Signature Date December 16, 2005

REMARKS FOR REQUEST FOR REVIEW

Claims 1-20, 27-33, and 35-46 are pending. The pending claims set forth a novel and non-obvious spinnerbait fishing lure. This inventive fishing lure has a frame formed from an integral length of polymeric material that provides the frame with the resilience to recover its original configuration after undergoing non-destructive bending as well as with the high strength and good durability needed to withstand repeated contact with rocks beneath the water or being bitten by fish. The lure also embeds a jig within the frame to reduce the risk of the jig snapping off with use. This not only prevents a valued lure from becoming worthless but contributes to increased environmental safety since it minimizes the incidence of waterfowl suffering lead poisoning from their ingestion of lead jig-heads lost in the water.

Claim 1 was rejected under 35 U.S.C. §103(a) as being unpatentable over Link (U.S. Patent No. 6,601,336) in view of Ogle (U.S. Patent No. 5,253,446). Claims 2-20, 27-33, and 35-38 are dependent to claim 1. Obviousness under 35 U.S.C. §103(a) requires that any combination or modification of the prior art must teach or suggest each and every one of the claim limitations. The references cited by the Examiner, however, do not teach or suggest all of the limitations set forth in independent claim 1.

The spinnerbait lure set forth in claim 1 includes a jig embedded within its frame. The Examiner asserts in the Office Action that this feature is disclosed only in Link and points to FIGS. 4 and 10 of that reference. In FIG. 4, the “jig” being referenced by the Examiner is a support rattle assembly. This assembly, however, has a flanged headpiece that is shaped to interconnect with, i.e. snap into, the recessed cavity of an end cap at the end of certain filaments. In FIG. 10, the jig is shown fitted with the elastomeric collar of what the Examiner asserts is a frame, the collar having a bore running its length that allows it to be slipped over the shaft of the jig.

None of the embodiments disclosed in Link teach or suggest a jig being embedded within the elastomeric collar or filaments of its various dressings. To embed is by definition “to fix into a surrounding mass: *to embed stones in cement.*” (The Random House College Dictionary Revised Edition © 1982 by Random House, Inc.) Quite to the contrary, in each instance, the dressing is a modular assembly that is no more than frictionally attached to the desired jig to provide for a variety of combinations and mounting arrangements in constructing a lure. This flexibility in removing or exchanging the assembly is in fact taught in the reference as being highly desirable in certain embodiments over having it molded to the lure. (See further remarks in Resp. of 6/27/05 at pg. 3).

The Examiner also asserts that Link discloses a frame having upper and lower arms in a predetermined shape in a non-stressed condition. The term “frame” is defined in the specification of the application as meaning an elongate member having a predetermined shape in its non-stressed condition such that its ends and angled vertices between the ends are in substantially fixed positions with respect to

one another. The “frame” pointed to by the Examiner in FIG. 4, however, is a dressing or assembly made from only elastomeric material. Such material is soft and easily deformable to enable the collar of the dressing to easily snap on and off the lure as well as to allow spinner blade or rattle assemblies to snap on or off its filaments. Moreover, the filaments will be continuously returning to a flaccid configuration after force-induced flexing is withdrawn, leaving the elastomer assembly in a shape that is continuously changing over time. (See further remarks in Resp. of 6/27/05 at pg. 3).

The Examiner also points to a “frame” in FIG. 10. This elastomer dressing has, however, only a single appending bored arm with an elastomer collar as an adjacent structure. This “frame,” therefore, does not comprise an elongate member and lacks both of the upper and lower arms set forth in claim 1.

The Examiner agrees that Link does not disclose a frame formed from an integral length of polymeric material. He asserts that Ogle shows such a frame, pointing specifically to column 4, lines 20-34 of that reference. This portion of the Ogle specification states that alternative embodiments of its lure may include “an elliptical ring made from polymeric materials.” The lure in Ogle is comprised, however, of both the ring and two extension arms. Ogle teaches a flow-through lure and the ring is an essential but distinct component from its arms. A hook and a spinner attachment are secured to the arms and not to the ring. There is no disclosure in Ogle of the arms being formed from plastic much less the asserted “frame”, i.e., ring and extension arms, being made from a single piece of polymeric material. (See further remarks in Resp. of 6/27/05 at pg. 4).

Even if Ogle could arguably be said to show a frame having at least one blade and a jig secured to it and formed from an integral length of polymeric material, the Examiner has failed to make the necessary showing of reasons or motivation within Link and Ogle that would support the combination and modification relied upon him in rejecting claim 1 under §103(a). The Examiner makes reference in the Office Action to how “it would have been obvious to one of ordinary skill in the art to take the device of Link and add the polymeric material of Ogle, so as to allow for the device to be made of differing colors attractive to fish.” This statement, however, is not the required showing of a motivation within the teachings of these references that one needs to have arrived at Applicant’s claimed invention. A specific explanation as to how a skilled artisan can extrapolate the invention from either Link or Ogle must be set forth by the Examiner. MPEP §706.02(j).

Nowhere in Link is there a teaching or suggestion that replacing the elastomer with certain polymers is, in any way, needed or desirable. It is simply an exercise in hindsight for the Examiner to call upon the supposed level of skill of one skilled in the art and then assert that the desired motivation comes from a need to make the assemblies different colors. If color was at all considered desirable by a skilled artisan, such color could be easily and more efficiently added to the elastomeric material itself. This can be seen with any box of colored rubber bands. The proposed modification by the Examiner is

both impractical and would make the device in Link highly unsatisfactory for its obviously intended purposes. (See further remarks in Resp. of 6/27/05 at pgs. 5-6).

Claim 3 was rejected as being obvious over Link in view of Ogle. It includes the limitation that a fishing line/leader is attachable with respect to the frame substantially adjacent to the frame-vertex. This feature is neither taught nor suggested by either Ogle or Link. The Examiner points to the eye of the jig-head in FIG. 1 of Link as showing this feature. The eye is, however, not substantially adjacent to but remote from what must constitute the frame-vertex in that figure – the elastomer collar – since this is the only construction consistent with the assertions made by the Examiner with respect to FIGS. 4 and 10. In Ogle, the Examiner is presumably referring to the point on the ring, as shown in FIG. 1, where the loop of the link is resting as constituting the frame-vertex. This does not teach or suggest, however, a frame-vertex from which the upper and lower arms of the frame extend divergently. Such a feature is more clearly seen in FIG. 1 at the point of the ring from where the arms extend. This is on the opposite side of the ring from the link in question and, therefore, not at all adjacent to where the fishing line/leader attaches to the frame. (See further remarks in Resp. of 6/27/05 at pg. 7).

Claims 35 and 36 were also specifically rejected as obvious over Link in view of Ogle. Claims 35 and 36 include limitations that are neither taught nor suggested by either Ogle or Link. The Examiner points to figures in each reference in support of his rejection of claim 35. These drawings (FIGS. 4 and 10 in Link and FIG. 1 in Ogle) are unable, by their nature, to disclose the frame being dimensioned so that it exhibits flexing resilience with use during fishing. Although some degree of oscillation may be inherent with an elastomer device, Link fails to disclose or describe a frame structure that is dimensioned to specifically exhibit flexing resilience. Claim 36 adds the limitation that the upper arm of the frame have an oblong cross-section. The Examiner points to the end caps in FIG. 4 of Link in support of this rejection. This structure discloses instead a circular cross-section. (See further remarks in Resp. of 6/27/05 at pgs. 8-9).

Claim 39 is an independent claim rejected under 35 U.S.C. §103(a) as being unpatentable over Link in view of Ogle. Claims 40-46 are dependent to claim 39. As explained above with respect to the allowance of claim 1, these references fail to teach or suggest, however, a frame having upper and lower arms in a predetermined shape in a non-stressed condition or a lure having an integral, polymeric frame. Link and Ogle also fail to teach or suggest the limitation that a fishing line/leader is attachable with respect to the frame substantially adjacent to the frame-vertex as explained earlier with respect to the allowance of claim 3. (See further remarks in Resp. of 6/27/05 at pgs. 9-12).

Claims 5-7, 10 and 11 were rejected as obvious over Link as modified by Ogle and further in view of Smith (U.S. Patent No. 4,640,040). Claims 6-13 are dependent to claim 5 which depends from claim 1. Claim 5 adds the limitation that the upper arm of a frame has an oblong cross-section where the

frame has upper and lower arms extending divergently from a frame-vertex. The Examiner acknowledges that Link as modified by Ogle fails to disclose such a limitation, even though this is contradictory with his rejections of claims 36 and 40. Although the Examiner states that such an upper arm is taught by Smith, the structure he identifies as such is described in the specification to the reference as being the rear track portion of a cyclic fishing lure. The lure in Smith therefore discloses neither upper nor lower arms extending from a frame-vertex. Even if arguably Smith did disclose an upper arm having an oblong cross-section, there is no adequate showing by the Examiner of the required motivation for applying Smith to Ogle and Link. The Examiner makes reference only to how "it would have been obvious to one of ordinary skill in the art to take the device of Link as modified by Ogle and add the upper arm of oblong cross section of Smith, so as to allow for objects to be movably connected to the frame." This assertion lacks any motivation for making the proposed combination to arrive at the claimed lure when the blade and the jig are to be secured to the frame, not movably connected to it. (See further remarks in Resp. of 6/27/05 at pg. 13).

Claim 6 has the additional limitation that the cross-section of the upper arm has an area that progressively decreases from the frame-vertex to the arm's distal-end. Although the Examiner states that this feature is disclosed in Smith in FIGS. 1, 2 and 6, no structure on the Smith lure is identified by the Examiner as serving as the frame-vertex. If track 12 arguably discloses an upper arm with an oblong cross-section, then the front towbar needs to be included as a portion of that arm. Only in this manner can the midpoint of the towbar be considered to constitute the frame-vertex since the frame-vertex must be substantially adjacent to where a fishing line/leader attaches with respect to the frame. The cross-sections of the sections extending in both directions from this point have, however, an area that remains constant and that do not decrease as required until the towbar connects with the track.

Claim 7 adds the restriction that the cross-section of the upper arm has its greater dimension in the plane of the frame. This feature is also not taught or suggested by Smith. If track 12 arguably discloses the upper arm claimed by the Applicant, then the drawings in Smith only show a structure having a cross-section with its longest dimension in a direction orthogonal to the plane of the lure. Moreover, substantial modification of the track in Smith would be necessary for this structure to have an upper surface that is wider than its side edge so as to arrive at the claimed device. Smith teaches against any such modification, however, since it would be inconsistent with the required configuration of the track, a configuration needed so that each of its ends can attach to the opposite ends of the towbar.

Claims 37, 38 and 41 were also rejected as being unpatentable over Link as modified by Ogle and further in view of Smith. Claims 37 and 38 add the limitations also set forth in claims 6 and 7 respectively. Claim 41 combines the limitations of claims 6 and 7. As explained above with respect to

the allowance of claims 6 and 7, none of the references cited by the Examiner teach or suggest such limitations. (See further remarks in Resp. of 6/27/05 at pgs. 15-16).

Claims 14, 31, 32, 44 and 45 were rejected under 35 U.S.C. §103(a) as being obvious over Link as modified by Ogle and further in view of Cheng (U.S. Patent No. 4,133,134). Each of the claims 14, 31 and 44 add the limitation that the integral length of polymeric material that forms the frame and is selected such that the frame always retains its original configuration absent force-induced flexing sufficient to break the frame be transparent. The Examiner agrees that this limitation is not disclosed by either Link or Ogle. He points to the hollow tube of the device in Cheng as teaching this restriction in the claims. This tube is, however, for receiving water soluble scented bait. This tube is rotatably mounted upon an elongated spinner shaft. A blade and a jig are shown in Chang secured to this shaft. Any disclosure in Chang, therefore, as to a frame is directed to the shaft of the lure made from a length of stiff metal wire, not its hollow tube. The Examiner also fails to present a proper motivation for applying Cheng to Ogle and Link.

Claims 32 and 45 add the limitation that the transparent polymeric frame of claims 31 and 44 respectively has color. The Examiner points to the flocked surface of a spinner blade and the tube in Cheng as showing this limitation. Flocking of the surfaces of both of these structures is to add texture not color to them. The texture is to provide a surface upon which the oil based scent materials released by the tube can adhere. The reference therefore fails to teach or suggest the claimed limitation. (See further remarks in Resp. of 6/27/05 at pgs. 16-17).

Claims 16-18 were rejected under 35 U.S.C. §103(a) as being obvious over Link as modified by Ogle and further in view of Sylla (U.S. Patent No. 6,226,917). Claim 16 adds the limitation that the integral length of polymeric material that forms the frame comprises polycarbonate. The Examiner agrees that this limitation is not disclosed by either Link or Ogle. He points to the end caps of the device in Sylla as teaching this restriction in the claim. These structures are mounted upon a wire frame. A blade and a jig are shown in Sylla secured to this frame. Any teaching of a frame in Sylla is directed therefore to the wire frame of the lure, not its end caps. Sylla teaches that the frame is made from wire, not polycarbonate. The Examiner furthermore does not present a proper motivation for applying Sylla to Ogle and Link. (See further remarks in Resp. of 6/27/05 at pgs. 17-18).

Claim 17 adds the same limitation as set forth in claim 3. For the same reasons given with respect to the allowance of claim 3, both Link and Ogle fail to teach or suggest this limitation. This failure is not overcome by Sylla. A frame-vertex from which upper and lower arms of a frame extend divergently alone is not present. Moreover, the front eyelet is the only structure on the wire frame proximal to the fishing line and it is remote from and not adjacent to the line, being separated by the spinner blade assembly. (See further remarks in Resp. of 6/27/05 at pgs. 18-19).

CONCLUSION

Applicant believes that claims 1-20, 27-33 and 35-46 include several structural features not disclosed or suggested in the prior art. Applicant submits that all rejections in the final Office Action of August 29, 2005 have been traversed by argument, placing the application in condition for allowance.

Respectfully submitted,



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